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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,451	11/21/2003	Koji Nozato	00862.023337	8049
5514 7590 08/16/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER PARK, CHAN S	
			ART UNIT 2625	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/717,451	Applicant(s) NOZATO, KOJI	
	Examiner CHAN S. PARK	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2003.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-11 and 13-21 is/are rejected.
- 7) ☐ Claim(s) 2 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

DOUGLAS Q. TRAN  
PRIMARY EXAMINER

*Douglas Q. Tran*

*Chan S. Park*

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/21/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the step of changing the derivation method of number of logical pages and the number of physical sheets according to the result of judgment in said judgment step (claims 3 and 13) must be shown or the feature(s) canceled from the claim(s). Perhaps, the judgment step should be included in fig. 10 of the Drawing. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Objections***

2. Claims 3 and 13 are objected to because of the following informalities:

Claim 3, lines 8-9, "wherein said derivation step changes a derivation method of the number of logical pages and the number of physical sheets" should be -- wherein said derivation step changes a method of calculating (or deriving) the number of logical pages and the number of physical sheets --.

With respect to claim 13, arguments analogous to those presented for claim 3, are applicable.

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 21 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Refer to page 53 of the Interim Guideline. The examiner suggests using the term -- A computer readable medium storing a computer program -- instead of "A program".

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. With respect to claim 3, it recites the limitation "wherein said derivation step changes a derivation method of the number of logical pages and the number of physical sheets according to a result of judgment in said judgment step". Upon careful review of the Specification, it is unclear if this change of the derivation method depends on where the usage information is acquired from. Rather, based on the fig. 10 of the Drawing, the change solely depends on the received print/job information. Explanation/clarification as to how the recited judgment step changes the derivation method is respectfully requested.

5. With respect to claim 13, arguments analogous to those presented for claim 3, are applicable.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 10, 11, 13, 20 and 21 is rejected under 35 U.S.C. 102(e) as being anticipated by Nishiyama U.S. Patent No. 6,714,316.

6. With respect to claim 11, Nishiyama discloses a server for managing usage information on a job issued from a client to an image forming apparatus (col. 9, lines 55-67), comprising:

acquisition means which acquires the usage information from said client or said image forming apparatus (col. 3, lines 58-65 & figs. 4, 7 & 10);

derivation means which derives the number of logical pages and the number of physical sheets from the usage information acquired by said acquisition means (col. 3, line 66 ~ col. 4, line 14 & figs. 5 & 6); and

output means which outputs the usage efficiency information of said image forming apparatus using the number of logical pages and the number of physical sheets derived by said derivation means (fig. 5).

7. With respect to claim 13, Nishiyama discloses the server according to claim 11, further comprising judgment means which judges whether the usage information acquired in said acquisition step is acquired from said client, from said image forming apparatus, or from both of said client and said image forming apparatus,

wherein said derivation means changes a derivation method of the number of logical pages and the number of physical sheets according to a result of judgment by

said judgment means (note that the calculation is changed based on the usage information transmitted from the host/printer according to fig. 5).

8. With respect to claim 20, Nishiyama discloses the server according to claim 11, further comprising display control means which displays the usage efficiency information, which is outputted by said output means, as a list for each user (col. 7, lines 11-19 & col. 5, lines 59-65).

9. With respect to claims 1 and 21, arguments analogous to those presented for claim 11, are applicable.

10. With respect to claim 3, arguments analogous to those presented for claim 13, are applicable.

11. With respect to claim 10, arguments analogous to those presented for claim 20, are applicable.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishiyama as applied to claim 13 above, and further in view of Miyake U.S. Patent No. 6,188,490.

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12. With respect to claim 14, Nishiyama discloses the server according to claim 13, but all print jobs appears to be normal printing jobs which do not include the layout information.

Miyake, the same field of endeavor of calculating the usage information for a print job, discloses the method of deriving the number of physical sheets from the number of logical pages and the layout information of the print job inputted by the user (col. 3, lines 38-62 & figs. 3~4).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the printing system of Nishiyama to receive print jobs with various layout information.

The suggestion/motivation for doing so would have been to provide the reduction process for the print jobs with the layout information.

Therefore, it would have been obvious to combine Nishiyama with Miyake to obtain the invention as specified in claim 14.

13. With respect to claim 15, the combination discloses the server according to claim 14, wherein the layout information is the number of logical pages to be laid out for one physical page (fig. 3 of Miyake & figs 5~6 of Nishiyama).

14. With respect to claim 16, Nishiyama discloses the server according to claim 13, wherein the number of physical sheets (available number of sheets sent by the printer to the server) is included in the usage information acquired from said image forming apparatus by said acquisition means and derivation means calculates the number of

logical pages that can be printed (the calculation is inherent according to the partial printing option shown in fig. 5).

However, Nishiyama does not explicitly disclose that the usage information includes the layout information in the original print job.

Miyake, the same field of endeavor of calculating the usage information for a print job, discloses the method of designating the layout information in the print job (col. 3, lines 38-62 & figs. 3~4).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the printing system of Nishiyama to receive print jobs with the layout information.

The suggestion/motivation for doing so would have been to provide the reduction process for the print jobs having different layout information.

Therefore, it would have been obvious to combine Nishiyama with Miyake to obtain the invention as specified in claim 16.

15. With respect to claim 17, the combination discloses the server according to claim 16, wherein the layout information is the number of logical pages to be laid out for one physical page (fig. 3 of Miyake & figs 5~6 of Nishiyama).

16. With respect to claim 18, Nishiyama discloses the server according to claim 13, but all print jobs appears to be normal printing jobs which do not include the layout information and the indication for the double/one sided printing mode.

Miyake, the same field of endeavor of the calculating the number of sheets required for a print job, discloses the method of deriving the number of physical sheets

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from the information indicating double/one sided printing mode and the layout information of the print job inputted by the user (col. 3, lines 38-62 & figs. 3~4).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the printing system of Nishiyama to receive print jobs with various layout information.

The suggestion/motivation for doing so would have been to provide the reduction process for the print jobs with the layout information.

Therefore, it would have been obvious to combine Nishiyama with Miyake to obtain the invention as specified in claim 18.

17. With respect to claim 19, Nishiyama discloses the server according to claim 13, wherein the number of physical sheets (available number of sheets sent by the printer to the server) is included in the usage information acquired from said image forming apparatus by said acquisition means and derivation means calculates the number of logical pages that can be printed (the calculation is inherent according to the partial printing option shown in fig. 5).

However, Nishiyama does not explicitly disclose that the usage information includes the information indicating double/one sided printing mode in the original print job.

Miyake, the same field of endeavor of calculating the usage information for a print job, discloses the method of designating either double/one sided printing mode in the print job (col. 3, lines 38-62 & figs. 3~4).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the printing system of Nishiyama to receive print jobs with the double/one sided printing mode information in the print job.

The suggestion/motivation for doing so would have been to provide the reduction process for the print jobs having the different printing mode information.

Therefore, it would have been obvious to combine Nishiyama with Miyake to obtain the invention as specified in claim 19.

Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishiyama as applied to claim 3 above, and further in view of Miyake.

18. With respect to claims 4-9, arguments analogous to those presented for claims 14-19, are applicable.

***Allowable Subject Matter***

19. **Claims 2 and 12** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Contact Information**

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DOUGLAS Q. TRAN  
PRIMARY EXAMINER

csp  
August 10, 2007

Chan S. Park  
Examiner  
Art Unit 2625

